

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks. Claims 1-6, 8-10 and 12-17 are pending of which claims 1, 10, 14 and 15 are independent.

Claim 1 was rejected under 35 U.S.C. §112 second paragraph.

Claims 1-6, 8-10 and 12-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsiounis (20010039535).

These rejections are traversed for the reasons stated below.

Claim Rejection Under 35 U.S.C. §112 Second Paragraph

Claim 1 was rejected under 112 second paragraph because "server arrangement" is allegedly unclear. "Server arrangement" has been amended to recite "server" in claim 1. Accordingly, the rejection is believed to be overcome.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Furthermore, as set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385.

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

If the above-identified criteria and rationales are not met, then the cited references fail to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited references.

Claims 1-6, 8-10 and 12-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsiounis.

Claim 1 recites,

a database with a plurality of merchant identification codes, each merchant identification code associated with a financial institution identification code in the database ... each of the adapter modules having a payment processing application identifying from the database a financial institution identification code associated with the merchant identification code from a payment request and interfacing with a data processing system of a financial institution identified by the financial institution identification code consistent with a communications protocol associated with the identified financial institution.

Tsiounis fails to teach or suggest a database with merchant ID codes and a financial institution code associated with each merchant ID code. Tsiounis also fails to teach or suggest using a merchant ID code to identify an associated financial institution code from the database to interface with the financial institution using a protocol consistent with a communications protocol associated with the identified financial institution.

The rejection alleges that these features are disclosed in Tsiounis in paragraphs 7-9, 25, 36, 80 and 23-69. Essentially, these cited paragraphs make up the majority of the Tsiounis reference. The rejection fails to indicate with any specificity which feature in

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

Tsiounis is being relied upon as allegedly teaching each claimed feature, leaving it up to the Applicant to guess which features in Tsiounis are being relied upon. This rejection does not comply with the MPEP section 706 which states, "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." The Examiner is requested in the next office action to indicate with specificity which feature in Tsiounis is being relied upon as allegedly teaching each claimed feature. Also, if another office action is mailed, it cannot be made final, because the Applicant has not been given a fair opportunity to respond to the rejection due to its lack of clarity.

Furthermore, the claimed features regarding the database are not taught or suggested in Tsiounis. Tsiounis discloses a Merchant ID in paragraph 36, but does not disclose a database storing Merchant ID codes and an associated financial institution code for each stored merchant ID code. Tsiounis does not disclose identifying a financial institution code from a database or using the financial institution code to interface with the financial institution using the protocol of the financial institution.

Claim 1 also recites,

plurality of adapter modules coupled to the database, each adapter module executable on the server arrangement, compatible with one of the plurality of protocol types, and coupled to a respective one of the communications channels, each adapter module receiving the payment requests from the data communications devices at the respective channel, each of the adapter modules having a payment processing application configured to identifying from the database a financial institution identification code.

Tsiounis fails to teach or suggest the claimed adapter modules. The rejection states,

PATENT

Atty Docket No.: 10013448-1

App. Scr. No.: 09/896,576

However adapter module adapted respective channels each of the adapter modules, are old and well known in the art and they are used to link computers in order to perform communication channels between these computers.

Adapter modules used in the claimed payment processing system are not well known. Instead, computers would have to use the communication protocol specified by the merchant or financial institution. As described in the Applicant's specification in paragraph 18, the protocol may be selected by the sender (i.e., the service provider) instead of the receiver (e.g., the merchant), because the payment processing system includes the claimed adapter modules. This is different from what it is known in the art, which requires all the senders to use the same protocol that is used by the receiver.

Furthermore, the rejection appears to ignore that claim 1 recites each adapter module including a payment processing application identifying from the database a financial institution identification code. Tsiounis fails to teach or suggest these features.

Independent claim 10 recites features similar to claim 1 described above, which are not taught or suggested by Tsiounis.

Independent claim 14 recites the adapter modules and database described above, which are not taught or suggested by Tsiounis. Claim 14 also recites,

means, such as software running on a computer, for identifying from the database for each payment request, the financial institution code associated with the merchant identification code.

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

This feature is not taught or suggested by Tsiounis. Also, independent claim 15 recites features similar to claim 14 described above, which are not taught or suggested by Tsiounis. For at least these reasons claims 1-6, 8-10 and 12-17 are believed to be allowable.

PATENT

Atty Docket No.: 10013448-1

App. Ser. No.: 09/896,576

Conclusion


In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: December 19, 2007

By


Ashok K. Mannava
Registration No.: 45,301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 865-5150 (facsimile)